The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 24

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

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BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DAVID E. HECKERMAN,
DAVID MAXWELL CHICKERING,
and DANIEL ROSEN

Appeal No. 2004-0431
Application 09/450,262[1]

HEARD: November 16, 2004

Before JERRY SMITH, BARRETT, and RUGGIERO, Administrative Patent Judges.

BARRETT, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134(a) from the final rejection of claims 1-4, 6-14, and 16-26. Claims 5 and 15 have been canceled.

We reverse.

[1] Application for patent filed November 29, 1999, entitled "Transmission of Information During Ad Click-Through."

BACKGROUND

The invention relates to the activation of ads displayed on Web pages, such as the clicking-through of banner ads, and to transmitting information during such banner ad activation. More specifically, ads are grouped into clusters where the cluster may be defined using user demographic information (e.g., it may be known that users of particular demographics when browsing particular types of Web pages are more likely to click on certain types of ads and a cluster could be defined for users of such demographics) or using information from advertisers themselves (e.g., information regarding the purchasing decisions of users). See specification, pages 11-12. When a user is browsing a particular Web page, the cluster in which the user is currently, based on information such as information regarding the user as well as the identification and/or type of Web page, determines the ads the user will see on that Web page. See specification, page 12. The specific one of the ads displayed from a cluster of ads is based on probability, e.g., as determined by a random number. See specification, page 12.

Claim 1 is reproduced below.

1. A computer-implemented method comprising:

selecting an ad to be displayed on a web page as one of a plurality of ads within a current cluster, each of the plurality of ads having a respective selection probability for being displayed;

displaying the ad selected on the web page;

detecting activation of the ad displayed; and

transmitting information to an entity associated with the ad upon detecting activation of the ad displayed, the transmitted information comprising information regarding the current cluster.

The examiner relies on the following reference:

McCollom et al. (McCollom) 6,343,274 January 29, 2002
(filed September 11, 1998)

Claims 1-4, 6-14, and 16-20 stand rejected under 35 U.S.C. § 102(e) as being anticipated by McCollom.

Claims 21-26 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over McCollom.

We refer to the final rejection (Paper No. 10) (pages referred to as "FR__") and the examiner's answer (Paper No. 15) (pages referred to as "EA__") for a statement of the examiner's rejection, and to the brief (Paper No. 14) (pages referred to as "Br__") and reply brief (Paper No. 16) (pages referred to as "RBr__") for a statement of appellants' arguments thereagainst.

OPINION

Appellants argue that claims 1, 8, 11, and 18 stand or fall together; claims 2 and 12 stand or fall together; claims 3, 9, 13, and 19 stand or fall together; claims 4 and 14 stand or fall together; claims 6 and 16 stand or fall together; claims 7, 10, and 20 stand or fall together; and claims 21-26 stand or fall together (Br3). At the time appellants' brief was filed, there were two requirements for claims to be considered separately:

(1) appellant must state that the claims do not stand or fall together; and (2) appellant must separately argue each claim which is said to be separately patentable. See 37 CFR § 1.192(c)(7) (2001). "If the brief fails to meet either requirement, the Board is free to select a single claim from each group of claims subject to a common ground of rejection as representative of all claims in that group and to decide the appeal of that rejection based solely on the selected representative claim." In re McDaniel, 293 F.3d 1379, 1383, 63 USPQ2d 1462, 1465 (Fed. Cir. 2002). The argument section of the brief only argues the separate patentability of claims 1, 8, 11, and 18 as one group and claims 21-26 as a second group. Accordingly, claims 1-4, 6-14, and 16-20 stand or fall together with claim 1 taken as the representative claim and claims 21-26 stand or fall together as a second group, if necessary, with claim 21 being taken as representative.

Appellants first argue that McCollom does not teach "transmitting information to an entity associated with the ad upon detecting activation of the ad displayed" (claim 1). It is argued (Br4):

> McCollom, et al. does not disclose or suggest transmitting information regarding the current cluster associated with the ad or display message upon detecting activation of the message. A merchant within McCollom, et al. must manually request a report and then specify the information wanted within the report (See col. 6, lines 52-55, 61-67, col. 7 lines 1-19). In contrast, the present claims require that transmitted information regarding the current cluster

> associated with the ad or display message is transmitted to the entity upon selection of the ad without any intervening actions by the entity - the advertising entity does not request any report.
>
> The examiner states (EA11):
>
> McCollom teaches a system that upon detecting activation of an ad transmits the information to an entity associated with an ad (see column 6, line 61 - column 7, line 19 and column 8). If the information is transmitted immediately or some time later would not patentably distinguish the claimed invention from the prior art.

Appellants respond that McCollom does not transmit information to an entity associated with an ad or display message upon detecting activation of the ad or display message, but rather the information is collected centrally by a third party commerce server and is only transmitted to an entity associated with the ad "(i) at a later time after a laborious process in which the commerce server aggregates data and produces reports and (ii) only when the reports are requested by the entity associated with the ad or display message" (RBr3). It is argued that McCollom rejects the idea of transmitting consumer information directly to merchants in favor of a system isolating merchant advertisers from consumers via a third party system and, so, teaches away from the claimed invention (RBr3).

McCollom is directed to a method for providing merchant advertisements to consumers. The method provides privacy of consumer identity and protected information while still providing marketing and demographic statistics to the merchant regarding

consumer advertisement accesses (col. 2, lines 7-13). A commerce server keeps demographic statistics and stores merchant advertisements. The user/consumer interacts with the commerce server which provides requested advertisements from specific merchants or from selected categories and collects statistics with regard to category advertisements that have been accessed by the consumer (col. 2, lines 43-54). The consumer can retrieve the latest advertisements from particular merchants or in particular categories (col. 3, lines 10-14) and can search merchant advertisements or category advertisements by key word categories and stores (col. 3, lines 28-31). Merchants sign up for advertising slots and specify categories for the advertisements to be included in and key words for identifying the merchant advertisement (col. 5, lines 40-43). The consumer program (a program associated with the browser) captures statistical information regarding the advertisements, such as the number of times each advertisement for each merchant in each category is seen and transmits it to the commerce server when it is first connected (Fig. 8; col. 8, lines 13-21; col. 8, line 55 to col. 9, line 3). Merchants are able to get reports on the statistics (col. 6, line 50 to col. 7, line 18).

Initially, we interpret the limitation, "an entity associated with the ad," as broad enough to read on the commerce server which receives and manages the advertisements because it

is broadly "associated" with the ad. The entity does not have to be the merchant as argued by appellants. We interpret the limitation, "transmitting information ... upon detecting activation of the ad displayed," in accordance with the plain meaning of the words, to require transmitting information at the time activation of the ad is detected, not at some later time. Therefore, we find the examiner's claim interpretation that "[i]f the information is transmitted immediately or some time later would not patentably distinguish the claimed invention from the prior art" (EA11) to be in error. McCollom stores statistics captured about each advertisement the consumer has viewed on the consumer program (i.e., a program associated with the browser) and transmits the statistical information when the consumer program connects to the commerce server (Fig. 8; col. 8, lines 3-24). That is, McCollom saves the information until there is a connection to the commerce server and does not transmit information "upon detecting activation of the ad displayed," as claimed. For this reason, McCollom fails to anticipate claim 1. Nevertheless, we also examine the other argued limitations.

Appellants secondly argue that McCollom does not teach "the transmitted information comprising information regarding the current cluster" (claim 1). It is argued that the information transmitted is related solely to the performance of the ad (e.g., the number of clicks) without any consideration given to the

cluster of ads that may also be displayed therewith and, further, that there is no defined relationship (e.g., cluster) between the respective merchant's ads in McCollom (Br5-6).

The examiner states that transmitting information regarding the current cluster is deemed to be inherent to the McCollom system as lines 3-25 of column 8 teach that the consumer program sends statistical information for the number of times each advertisement for each merchant in each category is seen, the percentage of advertisements viewed, and the total amount of time spent viewing the advertisement (EA11).

Appellants respond that the mere fact that McCollom transfers statistical information about advertisements viewed by consumers is not sufficient to suggest transferring current cluster data as claimed (RBr4).

We find that a "category" in which advertisements are placed in McCollom (e.g., col. 2, line 49; col. 3, lines 14 & 27; col. 5, lines 40-43) broadly corresponds to the claimed "cluster." At the telephone hearing, appellants argued that the categories in McCollom are not clusters because clusters, as described in the specification, are defined to maximize click-through, or activation, of the ads within the clusters. This argument was not raised in the briefs. Nevertheless, the specification broadly indicates that clusters are any logical grouping and states that "[t]he invention is not limited to a

manner by which ads are allocated to clusters, nor to a particular definition of clusters" (specification, page 11). McCollom teaches sending information regarding the category (cluster), e.g., "[t]he consumer program 100 also sends for each merchant ID advertisement and each category advertisement, the statistical information for each advertisement the consumer has viewed" (col. 8, lines 10-13). Also, since the reports in McCollom can indicate what share of ad clicks the merchant gets (col. 7, line 10), it is reasonably suggested that the share of ad clicks per category is reported. However, the limitation, "the transmitted information comprising information regarding the current cluster," is tied to the limitation, "transmitting information to an entity associated with the ad upon detecting activation of the ad displayed," which we found is not taught.

Appellants thirdly argue that McCollom does not teach "selecting an ad to be displayed on a web page as one of a plurality of ads within a current cluster, each of the plurality of ads having a respective selection probability for being displayed" (claim 1). It is argued that McCollom involves an ad-slot purchasing system where merchants have the option of buying slots for ads and categorizing the ads according to their preferences (Br7).

The examiner states that this feature is inherent in view of columns 7 and 8 which show capturing statistical information and

"[t]he advertisement that is displayed to the customers would have a selection probability with a bias of showing certain advertisements over others based on consumer statistical information" (EA12).

Appellants respond that even if McCollom discloses that certain ads are more likely to be displayed because of information gathered about a consumer's interests, this does not inherently disclose display messages or ads having selection probabilities with respect to a current cluster, especially since McCollom fails to teach employing clusters (RBr5-6).

While we find that the categories in McCollom are clusters, we agree with appellants that McCollom does not teach "each of the plurality of ads having a respective selection probability for being displayed." McCollom does not disclose that the ads in a category are randomly selected so as to have a selection probability. Nor is a selection probability necessarily inherent as stated by the examiner. McCollom can (and appears to) display or list all of the ads within a category and does not pick an ad at random from the category. For this additional reason, McCollom fails to anticipate claim 1.

Because we find that McCollom does not anticipate claim 1, the rejection of claims 1-4, 6-14, and 16-20 is reversed. No additional prior art is applied in the obviousness rejection of claims 21-26, nor do we find any suggestion in McCollom that

would make the missing limitations in claim 1 obvious. Thus, the rejection of claims 21-26 is also reversed.

REVERSED

JERRY SMITH
Administrative Patent Judge

LEE E. BARRETT
Administrative Patent Judge

JOSEPH F. RUGGIERO
Administrative Patent Judge

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AMIN & TUROCY, LLP
24TH FLOOR, NATIONAL CITY CENTER
1900 EAST NINTH STREET
CLEVELAND, OH 44114